R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

SUPPORT FOR THE CLAIM AMENDMENTS

Support for the claim amendments and new claims may be found in the specification, for example, on page 23 lines 3-13, page 33 lines 9-13, page 34 lines 12-13 and FIGS. 5, 8 and 9, as originally filed, and claims 10, 25 and 26 prior to the instant amendment. Thus, no new matter has been added.

CLAIM OBJECTIONS

The objection to claim 17 for informalities has been obviated by appropriate amendment and should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §112

The rejection of claim 7 under 35 U.S.C. §112, first paragraph, has been obviated by appropriate amendment and should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

The rejection of claims 1, 3, 5, 10, 12-15, 17, 23, 25 and 27 under 35 U.S.C. §102(e) as being anticipated by Ravikanth et al. '978 (hereafter Ravikanth) has been obviated in part by

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appropriate amendment, is respectfully traversed in part and should be withdrawn.

Ravikanth concerns a generic label encapsulation protocol for carrying label switched packets over serial links (Title). In contrast, claim 1 provides (in part) a first of a plurality of packets having one or more labels and a link layer address following the labels. In contrast, Ravikanth appears to be silent regarding a field sequence where a link layer address follows a label. Therefore, Ravikanth does not appear to disclose or suggest a first of a plurality of packets having one or more labels and a link layer address following the labels as presently claimed.

Claim 1 further provides a data identification portion having a plurality of bits, preceding the labels and configured to identify a data type of information in the first packet. In contrast, Ravikanth appears to be silent regarding a multi-bit data identification portion for packet information. Therefore, Ravikanth does not appear to disclose or suggest a data identification portion having a plurality of bits, preceding labels and configured to identify a data type of information in a first packet as presently claimed. As such, the claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Claim 17 provides a step for transmitting a frame comprising a packet envelope carrying a plurality of packets, a

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first of the packets having a first protocol and a second of the packets having a second protocol unrelated to said first protocol. In contrast, Ravikanth appears to be silent regarding a frame having a plurality of packets having different protocols. Therefore, Ravikanth does not appear to disclose or suggest a step for transmitting a frame comprising a packet envelope carrying a plurality of packets, a first of the packets having a first protocol and a second of the packets having a second protocol unrelated to said first protocol as presently claimed. As such, the claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Claim 25 provides a step for storing a path signal label in a Path Overhead section in a frame header of a frame to specify each type of one or more packets within a packet envelope. Despite the assertion on page 4 of the Office Action, the text on column 5, lines 59-62 of Ravikanth appear to be silent regarding **a Path Overhead section in a frame header** of a frame. Therefore, Ravikanth does not appear to disclose or suggest a step for storing a path signal label in a Path Overhead section in a frame header of a frame to specify each type of one or more packets within a packet envelope as presently claimed. As such, claim 25 is fully patentable over the cited reference and the rejection should be withdrawn.

Claim 27 provides steps for transmitting one or more labels of a first packet and transmitting a link layer address of the first packet after transmitting the one or more labels. Despite the assertion on page 5 of the Office Action, the text of Ravikanth in column 5, lines 24-25 and 55-59 appears to be silent regarding a transmission sequence. Therefore, Ravikanth does not appear to disclose or suggest steps for transmitting one or more labels of a first packet and transmitting a link layer address of the first packet **after transmitting** the one or more labels as presently claimed. As such, claim 27 is fully patentable over the cited reference and the rejection should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claim 16 under 35 U.S.C. §103(a) as being unpatentable over Ravikanth in view of Partridge et al. '819 (hereafter Partridge) is respectfully traversed and should be withdrawn.

The rejection of claim 9 under 35 U.S.C. §103(a) as being unpatentable over Ravikanth in view of Kashio et al. '811 (hereafter Kashio) is respectfully traversed and should be withdrawn.

The rejection of claim 21 under 35 U.S.C. §103(a) as being unpatentable over Ravikanth in view of Dantu et al. '088

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(hereafter Dantu) is respectfully traversed and should be withdrawn.

The rejection of claim 22 under 35 U.S.C. §103(a) as being unpatentable over Ravikanth in view of Ofek et al. '230 (hereafter Ofek) is respectfully traversed and should be withdrawn.

Ravikanth concerns a generic label encapsulation protocol for carrying label switched packets over serial links (Title). Kashio concerns an interconnection system and method for heterogeneous networks (Title). Partridge concerns a method and apparatus for multiplexing bytes over parallel communications links using data slices (Title). Dantu concerns a system and method for packet level distributed routing in fiber optic rings (Title). Ofek concerns packet switching with common time reference over links with dynamically varying delays (Title).

Claim 16 provides a frame comprising a packet envelope carrying a plurality of packets, wherein a first of the packets has a first protocol and a second of the packets has a second protocol unrelated to the first protocol. Despite the assertion on page 6 of the Office Action, the text in column 1, lines 50-52 of Partridge appears to be silent regarding a frame carrying packets with unrelated protocols. Applicant has stated in the Background section of the application on page 17, lines 11-17:

> Conventional approaches have the following disadvantages (i)
> **ATM and Packets are implemented on different rings because of
> QoS and timing issues**; (ii) very high cost for new fiber and
> SONET equipment for Telco/ISP/MAN; (iii) **only one type of**

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packet goes inside a SONET SPE at one time (the remaining bytes of frame on SONET are wasted) (SONET packets go around the entire SONET ring, limiting bandwidth); (Emphasis added)

At the time of the invention, SONET commonly handled multiple protocols by using separate rings and/or using separate frames. In contrast, Partridge does not discuss multiple protocols within a single SONET SPE. Therefore, Ravikanth and Partridge, alone or in combination, do not appear to teach or suggest a frame comprising a packet envelope carrying a plurality of packets, wherein a first of the packets has a first protocol and a second of the packets has a second protocol unrelated to the first protocol as presently claimed.

Furthermore, no evidence of motivation to combine the references has been provided. The argument on page 6 of the Office Action merely asserts that the combination may be possible. However, the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness (MPEP §2143.01). Therefore, prima facie obviousness has not been established for lack of clear and particular evidence of motivation to combine the references. As such, the claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Regarding claim 9, the asserted motivation on page 6 of the Office Action "in order to comply with IEEE standards 802.2 to 802.5" is a conclusion, not motivation. The Office Action fails to

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provide particular findings as to the reasons why a skilled artisan, with no knowledge of the presently claimed invention, would have modified the cited reference as suggested in the Office Action. The factual inquiry whether to modify the reference must be thorough and searching. The rigorous application of the requirement for showing the teaching or motivation to modify the reference is necessary to avoid the subtle but powerful attraction of a hindsight-based obviousness analysis. It is improper, in determining whether a person of ordinary skill in the art would have made the proposed modifications, simply to use that which the inventor taught against its teacher. As such, because the Office Action fails to provide particular findings as to the reasons a skilled artisan, with no knowledge of the presently claimed invention, would have chosen the proposed modification the Office Action does not appear to have met the Office's burden of factually establishing a *prima facie* case of obviousness (MPEP §2142 and §2143.01). As such, claim 9 is fully patentable over the cited references and the rejection should be withdrawn.

Claim 21 provides a frame comprising a packet envelope carrying a plurality of packets, wherein a first of the packets has one or more labels configured to control routing of the first packet through a network and a second of the packet is void of the labels. The Office Action asserts on page 7 that not having a label in a second packet would be obvious "in order to accommodate

networks that do not support MPLS as taught by Dantu." However, if the network does not support labels, the proposed combination of Ravikanth and Dantu does not appear to teach or suggest a first packet having one or more labels configured to control routing of the first packet through the network. If the network accommodates labels for the sake of the first packet, no motivation appears to exist for the second packet not to have a label. The proposed combination either (i) does not teach or suggest every claim limitation or (ii) there is no motivation to make the proposed combination. Therefore, *prima facie* obviousness has not been established. As such, claim 21 is fully patentable over the cited references and the rejection should be withdrawn.

Regarding claim 22, the Office Action does not appear to provide evidence of motivation to combine the references from either of the references or knowledge generally available to one of ordinary skill in the art. In particular, the alleged motivation on page 7 of the Office Action "in order to understand how an IPv4 packet is to be routed" is not credited to Ravikanth, Ofek or knowledge generally available to one of ordinary skill in the art. Therefore, the alleged motivation appears to be merely a conclusory statement. As such, *prima facie* obviousness has not been established for lack of motivation to combine.

Furthermore, no evidence of a reasonable expectation of success has been provided in the Office Action. In particular,

Ravikanth appears to be silent regarding the label switching routers 150 and/or 152 being capable of routing an IP packet based on a destination address within the IP packet. The proposed combination of Ravikanth and Ofek does not appear to be operational as asserted in the Office Action. Therefore, *prima facie* obviousness has not been established for lack of a reasonable expectation of success. As such, claim 22 is fully patentable over the cited references and the rejection should be withdrawn.

COMPLETENESS OF THE OFFICE ACTION

Aside from a notice of allowance, Applicant's representative respectfully requests any further action on the merits be presented as a non-final action. 37 CFR §1.104(b) states:

> (b) *Completeness of examiner's action*. The examiner's **action will be complete as to all matters**, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters of form need not be raised by the examiner until a claim is found allowable. (Emphasis added)

Claim 26 stands rejected per line 6 of the Office Action Summary yet no argument is presented in the body of the Office Action in support of the rejection. Furthermore, MPEP §2163, paragraph III states:

> The above only describes how to determine whether the written description requirement of 35 U.S.C. 112, para. 1, is satisfied. **Regardless of the outcome of that determination, Office personnel must complete the patentability**

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determination under all the relevant statutory provisions of title 35 of the U.S. Code.
Once Office personnel have concluded analysis of the claimed invention under all the statutory provisions, **including 35 U.S.C.** 101, 112, **102 and 103**, they should review all the proposed rejections and their base to confirm their correctness. (Emphasis added)

Claim 7 is rejected under 35 U.S.C. §112, first paragraph only. No 35 U.S.C. 102 and/or 103 arguments are presented in the Office Action for claim 7. As such, the Office Action mailed April 2, 2004 is not complete.
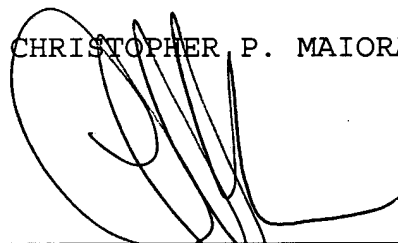
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

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Dated: <u>July 1, 2004</u>

Docket No.: 0325.00345